

**REMARKS**

Reexamination and reconsideration of the present application are requested.

Applicants have added new claims 19-20, both drawn to the previously elected species I. Accordingly, claims 1-20 remain pending in the application.

**35 U.S.C. § 102 and 103**

The Office Action rejected claim 1 under 35 U.S.C. § 102 over Luu U.S. patent 5,631,611 (“Luu”); claims 2, 6 and 7 under 35 U.S.C. § 103 over Luu in view of Whitley U.S. Patent 4,325,040 (“Whitley”); claims 3-5 under 35 U.S.C. § 103 over Luu and Whitley in view of Malliard U.S. Patent 4,222,022 (“Malliard”); and claims 8-9 under 35 U.S.C. § 103 over Luu and Whitley in view of U.S. Patent 5,309,120 (“Koontz”).

Applicants respectfully traverse those rejections for at least the following reasons.

**Claim 1**

Among other things, the apparatus of claim 1 includes a variable inductor having two inductors electrically coupled to each other.

Applicants respectfully submit that Luu does not disclose any apparatus including such a feature.

The Office Action has cited element 35 in Luu as supposedly corresponding to such a feature.

Applicants respectfully disagree.

Element 35 is an isolation transformer not an inductor. Element 35 *includes* two inductors L<sub>p</sub> and L<sub>s</sub>, but they are not coupled electrically to each other, and instead are only coupled magnetically. Indeed, Luu very specifically teaches that this electrical isolation is a key aspect of his invention:

“The invention provides electrical isolation between the input and output of the network due to the spacing of the input and output coils of

the transformer”

Luu at col. 1, lines 63-65 (emphasis added).

Accordingly, for at least this reason, Applicants respectfully submit that the apparatus of claim 1 is patentable over Luu.

Claims 2, 6, and 7

Claims 2, 6 and 7 depend from claim 1.

Applicants respectfully traverse any proposed combination of Luu and Whitley that would attempt to modify Luu so that the first and second inductors are electrically coupled and have a first end of the rotating inductor connected with an other end of the fixed conductor. As noted above, Luu teaches away from any such connection or electrical coupling which would modify Luu such that is could not longer serve one of its purposes (electrical isolation). In any event, the Office Action fails to provide any motivation from the prior art that would lead one to modify Luu according to Whitley, as the supposed motivation mentioned in the Office Action in fact does not exist. Luu’s transformer 35 is already completely adjustable; so why would connecting the two inductors “adjust the inductance value?”

Accordingly, Applicants respectfully submit that claims 2, 6 and 7 are all patentable over the cited art for at least these reasons, and for the following additional reasons.

Claim 2

Among other things, the two inductors of claim 2 each are formed of an oval and spiral shaped coil.

The Office Action concedes that Luu fails to disclose such a feature, but states that this “is a matter of design choice.”

Applicants respectfully traverse that statement.

Indeed, in the Office Action dated 13 August 2003, the Examiner has already stated that each of the various coils having the different shapes shown, for example, in FIGs. 2, 10, 12, etc. of Applicant’s specification are each “patently distinct

species.” Applicants respectfully fail to understand how the Examiner can maintain in one Office Action that the different shapes of the coils shown, for example, in FIGs. 2, 10, 12, etc. are patentably distinct, necessitating an election of species, and in the following Office Action maintain that such shapes are mere “design choices!”

Applicants respectfully traverse the statement that such features are mere “design choices” and respectfully request that the Examiner withdraw that statement. Alternatively, if the Examiner maintains that position, Applicants would respectfully request that the Examiner withdraw the election requirement of 13 August 2003.

Furthermore, Applicants see no mention in the Office Action of the claimed feature of claim 2 that the current flows in the fixed and rotating inductors are opposite to each other. Applicants respectfully request a citation to a disclosure of such a feature in the cited references, or a withdrawal of the rejection of claim 2.

#### Claim 7

Applicants also respectfully traverse the statement in the Office Action that the features of claim 7 are somehow a “matter of choice” that would be obvious “absent persuasive evidence that connection member having a gripper and locking member was significant.”

Applicants respectfully submit that it is not Applicants burden to prove that their claimed invention is “significant,” or even novel or non-obvious, but rather that it is the Examiner’s burden to provide *prima facie* evidence of obviousness to support a rejection under 35 U.S.C. § 103.

Meanwhile, it is well established that conclusory statements, unsupported by any facts or citations, cannot meet the Examiner’s burden under 35 U.S.C. § 103. See In re Lee 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) (“the examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references”) (emphasis added). See also M.P.E.P. § 2143.01:

“FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH PRIMA FACIE OBVIOUSNESS. A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).”

No such objective evidence has been offered here. Instead, only conclusory statements have been made without providing any objective evidence upon which such statements are founded. As explained above, such unsupported statements cannot form the basis of a claim rejection under 35 U.S.C. § 103.

In any event, although Applicants do not carry any burden to prove “significance” absent a *prima facie* showing of obviousness, Applicant’s specification has already explained at least one “significant” benefit of the features of claim 3 (see paragraph [0051], lines 10-12 on page 15).

Accordingly, for at least these additional reasons, Applicants respectfully request that the Examiner withdraw the rejection of claim 7.

Claims 3-5

Claims 3-5 depend from claims 1 and 2. Applicants respectfully submit that Malliard fails to cure the shortcomings of Luu and Whitley as explained above with respect to claims 1 and 2.

Accordingly, for at least these reasons, Applicants respectfully submit that claims 3-5 are all patentable over the cited prior art.

**Claims 8-9**

Claims 8-9 depend from claims 1 and 2. Applicants respectfully submit that Koontz fails to cure the shortcomings of Luu and Whitley as explained above with respect to claims 1 and 2.

Accordingly, for at least these reasons, Applicants respectfully submit that claims 8-9 are all patentable over the cited prior art.

**UNELECTED CLAIMS 10-18**

Applicants respectfully submit that claim 1 is generic to all of the species identified by the Examiner in the Office Action dated 13 August 2003.

Upon allowance of claim 1, Applicants respectfully request that the Examiner add the unelected claims 10-18 back into the application for examination.

**NEW CLAIMS 19 AND 20**

Applicants have added new claims 19 and 20. Applicants respectfully submit that claims 19 and 20 are directed to the elected species.

Among other things, the apparatuses of claims 19 and 20 each include a variable inductor comprising a first and second coil, one end of the first coil being directly electrically connected to one end of the second coil, as shown for example in paragraphs [0054]-[0055] and FIG. 6.

Such a feature is directly contrary to Luu which teaches that the input and output inductors of transformer 35 should be electrically isolated.

For at least these reasons, Applicants respectfully submit that claims 19 and 20 are patentable over the cited art.

**CONCLUSION**

In view of the foregoing explanations, Applicants respectfully request that the Examiner reconsider and reexamine the present application, add claims 10-18 back into the application, allow claims 1-20, and pass the application to issue. In the event

that there are any outstanding matters remaining in the present application, the Examiner is invited to contact Kenneth D. Springer (Reg. No. 39,843) at (703) 715-0870 to discuss these matters.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 50-0238 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17, particularly extension of time fees.

Respectfully submitted,

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